IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Atty. Docket No.: 007287.00015
Yakov KAMEN et al.	
Confirmation No.: 6955	
Application No.: 10/008,229	Group Art Unit: 2623
Filed: November 30, 2001	Examiner: Raman, Usha
For: METHOD AND SYSTEM FOR CONTENT BASED BROADCASTED PROGRAM SELECTION	

APPEAL BRIEF

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Sir:

This is an Appeal Brief filed in support of Appellants' Notice of Appeal filed herewith. Appeal is taken from the Final Office Action mailed March 2, 2010 (hereafter, "Final Office Action").

Please charge any fees to Deposit Account No. 19-0733. In addition, any extensions of time necessary for acceptance or entry of this paper are hereby requested.

REAL PARTY IN INTEREST
37 C.F.R. § 41.37(c)(1)(i)

The owner of this application, and the real party in interest, is JLB Ventures, LLC.

RELATED APPEALS AND INTERFERENCES
37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals or interferences.

STATUS OF CLAIMS
37 C.F.R. § 41.37(c)(1)(iii)

Claims 1-17, and 19-21 are rejected and presently appealed.

STATUS OF AMENDMENTS
37 C.F.R. § 41.37(c)(1)(iv)

No amendments have been made subsequent to final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER
37 C.F.R. § 41.37(c)(1)(v)

In making reference herein to various embodiments in the specification text and/or drawings to explain the claimed invention, Appellants do not intend to limit the claims to those embodiments; all references to the specification and drawings are illustrative unless otherwise explicitly stated. Appellants refer to the originally filed Specification for the cited support.

Independent claim 1 is directed to a method comprising providing a first set of categories of broadcasted programs. Specification, Abstract, l. 1, paragraphs [0007], l. 1, [0014], ll. 2-3, and [0015], ll. 2-3. The method further comprises providing a second set of categories of broadcasted programs. *Id.* at paras. [0007], ll. 1-3, [0014], ll. 11-12, and [0015], ll. 4-6. The method further comprises adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories a predetermined number of times, wherein the predetermined number of times is greater than 1. *Id.* at para. [0015], ll. 3-6, 14-16.

Independent claim 7 is directed to one or more tangible computer-readable media storing instructions that, when executed by a processor, cause the processor to perform a method, comprising providing a first set of categories of broadcasted programs. *Id.* at paras. [0007], l. 1, [0014], ll. 2-3, [0015], ll. 2-3, [0026], l. 1-[0029], l. 6. The method further includes providing a second set of categories. *Id.* at paras. [0007], ll. 1-3, [0014], ll. 11-12, and [0015], ll. 4-6. The method further comprises adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories a predetermined number of times, wherein the predetermined number of times is greater than 1. *Id.* at para. [0015], ll. 3-6, 14-16.

Independent claim 13 is directed to a system comprising a first unit to provide a first set of categories of content of broadcasted programs. *Id.* at paras. [0007], l. 1, [0014], ll. 2-3, [0015], ll. 2-3, [0021], ll. 2-3, and [0026], l. 1-[0029], l. 6. The system further includes a second unit coupled with the first unit to add a category from the first set to a second set of categories of broadcasted programs in response to selecting the category from the first set and tuning a broadcasted program viewing device, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the category from the first set, wherein the second unit further includes a user verification wherein a user approves the category from the first set being added to the second set prior to the category being added. *Id.* at paras. [0020], ll. 1-9, [0021], ll. 4-10, and FIG. 4, element 410.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
37 C.F.R. § 41.37(c)(1)(vi)

- Claims 7-12 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

- Claim 21 stands rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement.

- Claims 1, 7, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0104081 to Candelore et al. ("Candelore") in view of U.S. Patent No. 5,801,747 to Bedard ("Bedard").

- Claims 2 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore in view of Bedard and further in view of U.S. Patent No. 5,978,043 to Blonstein et al. ("Blonstein").

- Claims 3-5 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore in view of Bedard and further in view of U.S. Patent No. 5,635,989 to Rothmuller ("Rothmuller").

- Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore in view of Bedard and further in view of U.S. Patent Publication No. 2005/0204382 to Ellis et al. ("Ellis") and U.S. Patent No. 6,323,911 to Schein et al. ("Schein").

- Claims 13 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore in view of Ellis and further in view of Schein.

- Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore in view of Ellis and Schein and further in view of Blonstein.

- Claims 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore in view of Ellis and Schein and further in view of Rothmuller.

ARGUMENT
37 C.F.R. § 41.37(c)(1)(vii)

A.   Rejection of Claims 7-12 Under 35 U.S.C. § 101

1. *Independent Claim 7*

Independent claim 7 recites, among other features, one or more tangible computer-readable media storing instructions that, when executed by a processor, cause the processor to perform a method. The Final Office Action asserts that "a computer readable [sic] can be tangibly be [sic] realized in the form of electrical, optical, acoustical and other forms of propagated signals." Applicants respectfully disagree. Clearly, electrical, optical, acoustical and other forms of propagated signals do not constitute "tangible computer-readable media" as recited in claim 7. Accordingly, Applicants submit that claim 7 does recite patentable subject matter.

2. *Dependent Claims 8-12*

Claims 8-12 depend from claim 7 and recite a "tangible computer-readable media." Accordingly, Applicants submit that claims 8-12 also constitute patentable subject matter.

B.   Rejection of Claim 21 Under 35 U.S.C. § 112, First Paragraph

Claim 21 stands rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. The Final Office Action asserts, at p. 6-7, that the claim "contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Applicants respectfully disagree.

At least paragraphs [0014] and [0015] describe adding the a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories a predetermined number of times, wherein the predetermined number of times is greater than 1. It then follows that the predetermined number of times would be determined prior to providing the first set of categories in order to identify the first category of the first set of categories to be added and determine whether the threshold is met. Accordingly, Applicants respectfully submit that claim 21 is described in the Specification.

C.   Rejection of Claims 1, 7, 19 and 21 Based on Candelore and Bedard
   1. Independent Claim 1

Independent claim 1 recites, among other features, adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*, wherein the predetermined number of times is greater than 1. Applicants respectfully assert that neither Candelore nor Bedard, alone or in combination, teaches or suggests the features of claim 1.

Candelore describes a method and system for maintaining *relative* statistics for creating a list of favorites. *See* title. Candelore describes maintaining a "list of favorites based on relative statistics…wherein the relative statistics tracks the number of times a channel, program, actor,

director or theme was accessed." *See also* Candelore paras. [0045], [0046]. The Final Office Action asserts that "[b]y maintaining the relative statistics, the system is able to have a memory of how frequently a program/category is tuned and determine what the *most tuned to* programs are. The *most tuned to* programs are in turn compiled into a list of favorites..." *See* the Final Office Action at p. 2 (emphasis added). However, a program being a "most tuned to" program clearly does not constitute a category added to a second set of categories in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*, wherein the predetermined number of times is greater than 1, as recited in claim 1. Rather, the relative amount of viewing of the program *compared* to other programs is the criteria for adding a *program* the favorites list in Candelore.

Maintaining a list of favorites based on *relative* statistics clearly does not constitute adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*. Further, no predetermined threshold is described in Candelore as the addition of the program to a favorites list is based a comparison with viewing of other programs. The addition of Bedard fails to cure the deficiencies of Candelore with respect to claim 1.

Bedard describes a method and apparatus for monitoring television viewing activity to determine preferred categories of programming and preferred channels of a viewer. Abstract. Bedard also fails to teach or suggest adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*, wherein the predetermined number of times is greater than 1, as recited in claim 1. The method and apparatus of Bedard include adding a viewed *channel* to a list of preferred channels when the *channel* is viewed for a predetermined *amount of time*. *See* col. 4, lines 38-40 (emphasis added). At most, Bedard describes adding a category to a viewer profile based on viewing *a channel* associated with that category. *See* col. 4, lines 49-65 (emphasis added). Bedard fails to teach or suggest adding a category *in response to tuning a device to a broadcasted program fitting into the first category a predetermined number of times,*

wherein the predetermined number of times is greater than 1, as recited in claim 1. Instead, Bedard describes adding a channel to the list of channels when the channel is viewed once *for a given period of time.* *See* col. 5, lines 34-48. A length of viewing time, as described by Bedard, does not constitute a number of times tuned. Further, Bedard describes a system wherein a device may be tuned to a channel more than once but not added to the channel listing because the channel was not viewed for the minimum time required.

Further, Bedard clearly fails to teach or suggest adding a first *category* from the first set of categories to the second set of *categories* in response to tuning a device to a *broadcasted program* fitting into the first category a predetermined number of times. Rather, Bedard describes adding a category to a viewer profile based on a number of times a channel associated with that category has been viewed. According to Bedard, a category will be added only if the channel viewed is associated with that category. *Id.* The category will not be added to a viewer profile if a *broadcast program* in that category is viewed on a channel not associated with that category. *Id.* There is no teaching or suggestion in Bedard of adding a *category* to a set of *categories* based in response to tuning a device to a *program* fitting into the first category.

For at least these reasons, Applicants submit that claim 1 is patentably distinct from the cited combination of references.

2. *Independent Claim 7*

Independent claim 7 recites language similar to claim 1 and is allowable for at least the same reasons as discussed above with respect to claim 1, and further in view of the additional novel and non-obvious features recited therein.

3. *Dependent Claims 19 and 21*

Claims 19 and 21 depend from claim 1 and are allowable for at least the same reasons as their base claim and further in view of the additional novel and non-obvious features recited therein.

D. Rejection of Claims 2 and 8 Based on Candelore, Bedard and Blonstein

Claims 2 and 8 depend from claims 1 and 7, respectively, and are allowable for at least the same reasons as their base claims and further in view of the additional novel and non-obvious features recited therein. The addition of Blonstein fails to cure the deficiencies of Candelore and

Bedard with respect to claims 1 and 7. Further, claims 2 and 8 recite, among other features, removing a second *category* from the second set upon a selecting of the second *category* from the second set. None of the cited references, alone or in combination, teaches or suggests the features of claims 2 and 8. At most, Blonstein describes removing a *channel* from a favorites list. *See* col. 12, lines 23-30. However, there is no teaching or suggestion of removing a *category* as recited in claims 2 and 8. Thus, Applicants submit that claims 2 and 8 are allowable for at least this additional reason.

E.   Rejection of Claims 3-5 and 9-11 Based on Candelore, Bedard and Rothmuller

Claims 3-5 and 9-11 depend from claims 1 and 7, respectively, and are allowable for at least the same reasons as their base claims and further in view of the additional novel and non-obvious features recited therein. The addition of Rothmuller fails to cure the deficiencies of Candelore and Bedard with respect to claims 1 and 7.

Further, claims 3 and 9 recite, among other features, removing a second *category* from the second set upon a broadcasted program viewing device not being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the second category from the second set. None of the cited references, alone or in combination, teaches or suggests the features of claims 3 and 9. At most Rothmuller describes removing a program *title* from a favorite program list based upon expiration of a predefined time period. There is absolutely no teaching or suggestion of removing any category, let alone a *category* from a set of categories upon a broadcast viewing device *not being tuned* for a period of time at least equal to a first predetermined threshold, to at least one broadcasted *program* predetermined to be in the second category from the second set. In fact, Rothmuller fails to teach or suggest removing any item based on a viewing device not being tuned to a program, as recited in claims 3 and 9. Thus, Applicants submit that claims 3 and 9 are allowable for at least this additional reason.

F.   Rejection of Claims 6 and 12 Based on Candelore, Bedard, Ellis and Schein

Claims 6 and claim 12 depend from claims 1 and 7, respectively, and are allowable for at least the same reasons as their respective base claims and further in view of the additional novel

and non-obvious features recited therein. The addition of Ellis and Schein fail to cure the deficiencies of Candelore and Bedard with respect to claims 1 and 7. Accordingly, Applicants respectfully request withdrawal of these rejections.

G. Rejection of Claims 13 and 20 Based on Candelore, Ellis and Schein

1. Independent Claim 13

Claim 13 recites, among other features, a first unit providing a first set of categories of content of broadcasted programs and a second unit coupled with the first unit and configured to add a category from the first set to a second set of categories of broadcasted programs *in response to selecting the category* from the first set and *tuning a broadcasted program viewing device,* for a period of time at least equal to a first predetermined threshold, *to at least one broadcasted program predetermined to be in the category* from the first set, wherein the second unit further includes a user verification wherein a user approves the category from the first set being added to the second set prior to the category being added. Applicants respectfully submit that none of Candelore, Ellis or Schein, alone or in combination, teaches or suggests the features of claim 13.

Similar to the discussion above, Candelore fails to teach or suggest adding a category from the first set to a second set of categories of broadcasted programs *in response to selecting the category* from the first set and *tuning a broadcasted program viewing device,* for a period of time at least equal to a first predetermined threshold, *to at least one broadcasted program predetermined to be in the category* from the first set, as recited in claim 13. At most, Candelore describes adding a program to a favorites list based on *relative* viewing statistics. *See* paras. [0045], [0046]. There is absolutely no teaching or suggestion in Candelore of adding a <u>category</u> to a second set and tuning a broadcasted program viewing device for a period at least equal to a first predetermined threshold. As discussed above, adding a program to a favorites list based on relative statistics does not constitute tuning a broadcast program viewing device for a period at least equal to a first predetermined threshold. The addition of Ellis and Schein fails to cure the deficiencies of Candelore with respect to claim 13. Accordingly, Applicants respectfully submit that claim 13 is allowable over the cited combination of references.

2. Dependent Claim 20

Claim 20 depends from claim 13 and is allowable for at least the same reasons as its base claim and further in view of the additional novel and non-obvious features recited therein.

H.   Rejection of Claim 14 Based on Candelore, Ellis, Schein and Blonstein

Claim 14 depends from claim 13 and is allowable for at least the same reasons as its base claim and further in view of the additional novel and non-obvious features recited therein. The addition of Blonstein fails to cure the deficiencies of Candelore, Ellis and Schein with respect to claim 13. Further, claim 14 recites, among other features, wherein the second unit is also configured to remove a category from the second set upon a selecting of the category from the second set. As discussed above, at most, Blonstein describes removing a *channel* from a favorites list. *See* col. 12, lines 23-30. However, there is no teaching or suggestion of removing a *category* as recited in claim 14. Thus, Applicants submit that claim 14 is allowable for at least this additional reason.

I.   Rejection of Claims 15-17 Based on Candelore, Ellis, Schein and Rothmuller

Claims 15-17 depend from claim 13 and are allowable for at least the same reasons as their base claims and further in view of the additional novel and non-obvious features recited therein. Accordingly, Applicants respectfully request withdrawal of these rejections.

CONCLUSION

For all of the foregoing reasons, Appellant respectfully submits that the final rejection of claims 1-17 and 19-21 is improper and should be reversed.

Respectfully submitted,

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CLAIMS APPENDIX
37 C.F.R. § 41.37(c)(1)(viii)

Claims involved in the appeal:

Claim 1.　　A method comprising:

　　providing a first set of categories of broadcasted programs;

　　providing a second set of categories of broadcasted programs; and

　　adding a first category from the first set to the second set of categories of broadcasted

programs in response to tuning a broadcasted program viewing device to a broadcasted program

fitting into the first category of the first set of categories a predetermined number of times,

wherein the predetermined number of times is greater than 1.

Claim 2.　　The method of claim 1, further comprising:

　　removing a second category from the second set upon a selecting of the second category

from the second set.

Claim 3.　　The method of claim 1, further comprising:

　　removing a second category from the second set upon a broadcasted program viewing

device not being tuned, for a period of time at least equal to a first predetermined threshold, to at

least one broadcasted program predetermined to be in the second category from the second set.

Claim 4.　　The method of claim 1, further comprising:

　　tuning a broadcasted program viewing device to a channel on which a broadcasted

program predetermined to be in a second category from the second set will be broadcasted within

a predetermined threshold of a current time.

Claim 5.　　The method of claim 1, further comprising:

tuning a broadcasted program viewing device, upon a singular pressing of a button, to a channel on which a broadcasted program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of a current time.

Claim 6.   The method of claim 1, further comprising:

verifying the adding of the first category from the first set to the second set including receiving user input confirming the addition of the first category.

Claim 7.   One or more tangible computer-readable media storing instructions that, when executed by a processor, cause the processor to perform a method, comprising:

providing a first set of categories of broadcasted programs;

providing a second set of categories; and

adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories a predetermined number of times, wherein the predetermined number of times is greater than 1.

Claim 8.   The one or more tangible computer-readable media of claim 7, wherein the method further comprises:

removing a second category from the second set upon a selecting of the second category from the second set.

Claim 9.   The one or more tangible computer-readable media of claim 7, wherein the method further comprises:

removing a second category from the second set upon a broadcasted program viewing device not being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the second category from the second set.

Claim 10.   The one or more tangible computer-readable media of claim 7, wherein the

method further comprises:

tuning a broadcasted program viewing device to a channel on which a broadcasted

program predetermined to be in a second category from the second set will be broadcasted within

a predetermined threshold of a current time.

Claim 11.   The one or more tangible computer-readable media of claim 7, wherein the

method further comprises:

tuning a broadcasted program viewing device, upon a singular pressing of a button, to a

channel on which a broadcasted program predetermined to be in a second category from the

second set will be broadcasted within a predetermined threshold of a current time.

Claim 12.   The one or more tangible computer-readable media of claim 7, wherein the

method further comprises:

verifying the adding of the first category from the first set to the second set including

receiving user input confirming the addition of the first category.

Claim 13.   (Currently Amended) A system comprising:

a first unit providing a first set of categories of content of broadcasted programs; and

a second unit coupled with the first unit and configured to add a category from the first

set to a second set of categories of broadcasted programs in response to selecting the category

from the first set and tuning a broadcasted program viewing device, for a period of time at least

equal to a first predetermined threshold, to at least one broadcasted program predetermined to be

in the category from the first set, wherein the second unit further includes a user verification

wherein a user approves the category from the first set being added to the second set prior to the

category being added.

Claim 14.   The system of claim 13, wherein the second unit is also configured to remove a category from the second set upon a selecting of the category from the second set.

Claim 15.   The system of claim 13, wherein the second unit is also configured to remove a category from the second set upon a broadcasted program viewing device not being tuned, for a period of time at least equal to a second predetermined threshold, to at least one broadcasted program predetermined to be in the category from the second set.

Claim 16.   The system of claim 13, wherein the second unit is also configured to tune a broadcasted program viewing device to a channel on which a broadcasted program predetermined to be in a category from the second set will be broadcasted within a predetermined threshold of a current time.

Claim 17.   The system of claim 13, wherein the second unit is also configured to tune a broadcasted program viewing device, upon a singular pressing of a button, to a channel on which a broadcasted program predetermined to be in a category from the second set will be broadcasted within a predetermined threshold of a current time.

Claim 19.   The method of claim 1, wherein the first and second sets are located in a set top box.

Claim 20.   The system of claim 13, wherein the first and second units are located in a set top box.

Claim 21.   The method of claim 1, wherein the predetermined number of times is predetermined prior to providing the first set of categories of broadcast programs.

EVIDENCE APPENDIX
37 C.F.R. § 41.37(c)(1)(ix)

NONE.

RELATED PROCEEDINGS APPENDIX
37 C.F.R. § 41.37(c)(1)(x)

NONE.